

**UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF PENNSYLVANIA**

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**JOY TECHNOLOGIES, INC. and  
JOY MM DELAWARE, INC.,**

Civil Case No. 05-1066

Plaintiffs,

vs.

**NARCO  
North American Rebuild Co., Inc.,**

Defendant.

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**AMENDED STIPULATED ORDER FOR PERMANENT INJUNCTION AND  
DISMISSAL OF ACTION SUBJECT TO TERMS**

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This matter, having come for consideration upon the complaint of the plaintiffs, Joy Technologies, Inc. and Joy MM Delaware, Inc. (hereinafter "Joy") for trademark infringement, unfair competition and state-law identity theft, and the parties having stipulated to the entry of a permanent injunction against Defendant North American Rebuild Co., Inc. ("NARCO" or "Defendant") and to dismissal of the above-captioned action subject to the terms provided herein:

**IT IS HEREBY ORDERED, ADJUDGED AND DECREED:**

1. This Court has jurisdiction over this action under the laws of the United States, 15 U.S.C. § 1051 et seq., and 28 U.S.C. §§ 1331, 1338, 1367, and over the parties to this suit. The claims arising under the laws of the State of Pennsylvania are joined with substantial and related claims under the trademark laws of the United States.

2. Joy is the owner of the trademarks JOY, JOY MINING, and JOY & DESIGN, including United States Registration Nos. 1,153,610 and 2,545,032 therefor, which are valid and

enforceable and constitute *prima facie* evidence of Joy's ownership of said marks and use of those marks in commerce on and in connection with the goods recited in said registrations and substantially related goods. Printouts of the referenced registrations are attached hereto as Exhibit A (the "Joy Trademarks").

3. Defendant acknowledges the validity and enforceability of the Joy Trademarks and the registrations therefor.

4. Defendant and its agents, employees, servants, representatives, officers, directors, shareholders, subsidiaries, affiliates, and all of their successors and assigns and any and all persons acting in concert with them (collectively "the Enjoined Persons") are permanently and perpetually enjoined and restrained from doing any of the following, directly or indirectly, and from aiding, abetting, or inducing anyone else to do any of the following and from contributing to anyone else doing any of the following:

(a) Using, or aiding, abetting, inducing or licensing any other party to use, any trademark or tradename that incorporates (i) the Joy Trademarks either alone or in combination with any other words or design elements, or (ii) any other mark which so resembles the Joy Trademarks as to be likely to cause confusion, deception or mistake, on or in connection with the advertisement, offering for sale, or sale of any goods or services not originating with and not authorized entirely by Joy; provided, however, that NARCO may use replacement parts or component parts bearing the Joy Trademarks consistent with Paragraphs 5, 8 and 11 below and with any applicable purchase agreements;

(b) Passing off, inducing or enabling others to pass off any product or service as originating with or authorized by Joy, if said product or service did not originate with and was not authorized by Joy;

(c) Taking any actions that cause or tend to cause third parties to believe that NARCO is an authorized dealer or licensee of Joy or otherwise affiliated with Joy, including but not limited to making representations to third parties, either implicitly or explicitly, concerning authorization from or affiliation with Joy, maintaining any telephone directory listings, maintaining web sites or internet links, maintaining any advertisements, or using any signage, letterhead, or business cards incorporating in any way the Joy Trademarks or any colorable imitation of those marks;

(d) diluting or infringing the rights of Joy in and to the Joy Trademarks; and

(e) challenging the validity or enforceability of the Joy Trademarks or any registrations therefor in any proceeding brought by Joy to enforce the provisions of this Stipulated Order for Permanent Injunction and Dismissal of Action Subject to Terms or in any other proceeding whatsoever.

5. When, in the process of fabricating, building, or rebuilding a mining shuttle car originally manufactured by Joy, NARCO replaces one or more of the following items:

- the canopy
- the controller case, or
- any drives

with a part that is either not made by Joy or not made solely as a replacement part, NARCO will remove any Joy serial number plate and any Joy 2-G tag from the mining shuttle car.

6. If any of the parts identified in Paragraph 5 above are replaced by NARCO on a particular mining shuttle car, NARCO shall affix its own NARCO serial number and NARCO 2-G tag to the machine.

7. So long as NARCO does not replace one or more of the items In paragraph 5 or

replaces one or more of said items only with new parts that are made by JOY, NARCO may repair, replace parts, refurbish or perform other field modifications to mining machines manufactured by JOY without removing the JOY serial number plate or the JOY 2-G plate, however NARCO shall affix to the mining machine a separate label, which label shall state as follows:

THIS PRODUCT HAS BEEN REBUILT BY NORTH AMERICAN REBUILD CO., INC. ITS OPERATING CHARACTERISTICS, AS SET BY THE ORIGINAL MANUFACTURER, MAY HAVE BEEN MODIFIED.

Such label shall not contain any language other than the foregoing sentences. The print on such label and the position of the label on the mining machine shall be conspicuous, such that the label shall be readable by the operator during normal operation of the machine.

8. In the event that NARCO uses a non-JOY frame for a mining shuttle car, the parties agree (1) that such mining machine shall be a NARCO machine, (2) that NARCO shall remove any Joy Trademarks, Joy serial numbers or Joy 2-G tags from the machine, except that NARCO may allow Joy Trademarks to remain on Joy manufactured component parts, (3) that NARCO shall place its own serial number and 2-G tags on the machine, and (4) that NARCO shall affix to the rebuilt machine the label described in Paragraph 7 above in the same manner as described in Paragraph 7 above.

9. When, in the process of fabricating, building, rebuilding or repairing a continuous miner that was originally manufactured by Joy, NARCO replaces all or more than fifty percent (50%) of the frame, or substantially changes the dimensions of the frame, NARCO shall remove any Joy serial number plate and any Joy 2-G tag from the rebuilt machine and shall not affix any Joy serial number plate or Joy 2-G tag to the rebuilt machine. For all continuous miners that are

covered by this Paragraph 9, NARCO shall affix to the rebuilt machine the label described in Paragraph 7 above in the same manner as described in Paragraph 7 above.

10. NARCO will not use orange paint on any rebuilt or manufactured mining machines, including mining shuttle cars, that come within the scope of Paragraphs 5, 8 and 9 hereof. This restriction shall not apply if the customer requests that the mining machine be painted orange.

11. All NARCO proposals, invoices and parts manuals for rebuilt or manufactured mining machines, including mining shuttle cars, coming within the scope of Paragraphs 5, 8 and 9 hereof will clearly indicate that the mining machine in question is a NARCO rebuilt product. This restriction shall not prohibit NARCO from including within its documents, original Joy documents that correspond to parts manufactured by Joy and then on the mining machine at issue.

12. If Joy discovers any use of the Joy Trademarks or any offensive statements, content or language on Defendant's or Enjoined Persons' Internet websites or in other content in the possession, custody or control of Defendant or Enjoined Persons that do not comply with the provisions of this Stipulated Order for Permanent Injunction and Dismissal Subject to Terms or if Joy discovers any products worked on by NARCO that do not conform to this Stipulated Order for Permanent Injunction because of NARCO actions, Joy may file a motion with this Court, upon proper notice to NARCO, requesting the entry of an Order for contempt and the imposition of sanctions.

13. Subject to the terms of this Stipulated Order for Permanent Injunction, all claims asserted by Joy against NARCO, as set forth in the Complaint in the above-captioned action, shall be dismissed with prejudice.

14. By entering into this Stipulated Order for Permanent Injunction and Dismissal of Action subject to Terms, NARCO does not admit to liability to Joy or to the violation of any law.

15. Jurisdiction is retained by this Court for the purpose of ensuring compliance with the terms of this Stipulated Order for Permanent Injunction and for enabling the parties to apply to this Court for further orders.

Dated this 22<sup>nd</sup> day of September, 2006.

**Pietragallo, Bosick & Gordon**

**Dickie, McCamey & Chilcote, P.C.**

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(412) 281-2272  
*Attorneys for Defendant*  
*North America Rebuild Co, Inc.*

**IT IS SO ORDERED.**

Dated this \_\_\_\_ day of \_\_\_\_\_, 2006.

**BY THE COURT:**

\_\_\_\_\_  
Honorable \_\_\_\_\_  
United States District Judge

**EXHIBIT A**

**JOY TRADEMARKS & REGISTRATIONS THEREFOR**



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### Typed Drawing

Word Mark JOY  
 Goods and Services

IC 006. US 013 023. G & S: Metal Goods Used in Mining and General Industries-Namely, Sheaves, Pulleys, Blocks Adapted for Use with Sheaves or Pulleys; Metal Chains and Chain Conveyor Flights; Cutter Bit Blocks Adapted to Mount on Cutter Chains, Bit Holders to Hold Bits in Cutter Bit Blocks; Metal Scrapers of the Drag Bucket Type for Digging Earth or Ore; Metal Goods Used in Well Drilling Operations-Namely, Tong Blocks, Bumper Subs, Bushings, Casing Bowls, Clamps, Collars, Hooks, Liners, Links, Pipes, Rods, Shoes, Slips, Spiders, Subs, Tongs, Well Heads; and Parts Therefor. FIRST USE: 19550801. FIRST USE IN COMMERCE: 19550801

IC 007. US 023. G & S: Mining Machines for the Extraction of Bedded Materials-Namely, Continuous Miners, Long Wall Mining Machines, Short Wall Mining Machines, Kerf Cutters, Shearing Machines, Drilling Machines, Percussive Hammers, Impact Hammers; Machines for Loading, Hauling and Dumping of Minerals, Coal and Other Material-Namely, Conveyors, Endless Belt Conveyors, Conveyor Supports, Gathering Arm Loaders, Shovel Type Loaders, Scraper Type Loaders, Shuttle Car Conveyor; Mine Roof Support and Roof Maintenance Machines-Namely, Hydraulically Operated Roof Support Machines, Roof Shields, Roof Chocks, Roof Drilling Machines, Roof Bolting Machines; Fluid Compressors-Namely, Air Compressors, Rotary Compressors, Reciprocal Compressors, Centrifugal Compressors, Screw Compressors, Recycle Gas Compressors, Pneumatic Motors; Well Drilling Machines-Namely, Pipe, Casing and Drill Rod Handling Apparatus, Make-Up and Break-Out Machines for Assembling and Disassembling Pipe, Tubing and Rod Sections, Power Tongs, Power Slips, Kelly Drives, Pulsation Stabilizing Machines, Elevators; Mechanical Dust Collector Machines; Machines for Mineral, Coal and Chemical Processing-Namely, Thickeners, Clarifiers, Flotation Cells for the Separation of Particulate Matter from a Liquid Medium, Pumps, Ball Mills, Rod Mills, Attrition Scrubbers, Heat Exchangers, Agitators, Disc Filters, Samplers for Obtaining Samples of Material from a Flow of Minerals or Chemicals, Settlers, Mixers, Mineral Jigs, Pulp Distributors, Machines for the Recovery of Placer Gold by Washing and Screening of Sand and Gravel, Jar Mills, Crushers, Pulverizers, Pressure and Vacuum Filters, Concentrating Tables for Gravity Separation of Two or More Minerals, Vibrating Screens, Feeders and Parts Therefor. FIRST USE: 19240707. FIRST USE IN COMMERCE: 19240707





IC 009. US 021. G & S: Electrical and Scientific Goods-Namely, Electrical Switches, Housings for Single and Multiple Switching Units; Electrical Connectors Both Line and Terminal Types, Ship to Shore Electrical Connectors, Aircraft and Runway Electrical Power Distribution Connectors, Highway Lighting Electrical Power Connectors, Electric Plugs and Receptacles, Low Voltage Power Distribution Boxes, Ground Fault Detectors, Electrical Circuit Continuity Detectors and Parts Therefor and Electrostatic Precipitators. FIRST USE: 19290200. FIRST USE IN COMMERCE: 19290200

IC 011. US 021 034. G & S: Environmental Control Apparatus, Pollution Control Equipment and Gas Cleaning Equipment-Namely, Gas Scrubbers, Air Chambers to House Bag Type Filters, Dust Valves and Air Locks; Ventilation and Gas Handling Apparatus-Namely, Fans, Centrifugal, Vane, Axial, Tube Axial and Propeller Types, Sound Attenuators for Reducing Fan Noise; Lamp Sockets; Electric Heaters Used for Vulcanizing; and Parts Therefor. FIRST USE: 19470310. FIRST USE IN COMMERCE: 19470310

IC 012. US 019. G & S: Crawler and Rubber Tire Land Vehicles for Transporting Mining and Excavation Equipment or Material; Shuttle Cars; and Parts Therefore. FIRST USE: 19371103. FIRST USE IN COMMERCE: 19371103

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 73161191

**Filing Date** March 6, 1978

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** February 17, 1981

**Registration Number** 1153610

**Registration Date** May 12, 1981

**Owner** (REGISTRANT) Joy Manufacturing Company CORPORATION PENNSYLVANIA Oliver Bldg. Pittsburgh PENNSYLVANIA 15222

(LAST LISTED OWNER) JOY MM DELAWARE, INC. CORPORATION BY ASSIGNMENT, BY ASSIGNMENT, BY ASSIGNMENT, BY ASSIGNMENT, BY ASSIGNMENT, BY ASSIGNMENT DELAWARE 2751 CENTERVILLE ROAD, SUITE 310 WILMINGTON DELAWARE 19808

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** JAMES EARL LOWE JR

**Prior Registrations** 1127184

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Affidavit Text** SECT 8 (6-YR). SECTION 8(10-YR) 20010925.

**Renewal** 1ST RENEWAL 20010925

**Live/Dead Indicator** LIVE

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### Word Mark JOY

### Goods and Services

IC 007. US 013 019 021 023 031 034 035. G & S: Mining machines for the extraction of bedded materials comprising continuous miners, longwall mining machines, Keri cutters, shearing machines, drilling machines, machinery for loading, hauling and dumping of minerals, coal and other material, such machinery comprising conveyor apparatus for continuous transportation of bulk materials, endless belt conveyors, conveyor supports, gathering arm loaders, scraper type loaders, shuttlecar conveyor, mine roof support and roof maintenance machinery comprising hydraulically operated roof support machines, roof shields, roof chocks, roof drilling machines, roof bolting machines; machinery for air pollution control comprising mechanical dust collectors; fluid compressors comprising air compressors, rotary compressors, reciprocal compressors, centrifugal compressors, screw compressors, recycle compressors, pneumatic motors. FIRST USE: 19630514. FIRST USE IN COMMERCE: 19630514

IC 009. US 021 023 026 036 038. G & S: Electrical and scientific goods comprising electrical switches and housing for single and multiple switching units, electrical connectors both line and terminal types. FIRST USE: 19630514. FIRST USE IN COMMERCE: 19630514

IC 012. US 019 021 023 031 035 044. G & S: Crawler and rubber tire land vehicles for transporting mining and excavation equipment and material comprising conveyors, cutters, rotary drills, shuttle cars, and parts thereof. FIRST USE: 19630514. FIRST USE IN COMMERCE: 19630514

### Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

B

**Design Search Code** 010702  
**Serial Number** 76290109  
**Filing Date** July 25, 2001  
**Current Filing Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** December 11, 2001  
**Registration Number** 2545032  
**Registration Date** March 5, 2002  
**Owner** (REGISTRANT) Joy MM Delaware, Inc. CORPORATION DELAWARE 2751 Centerville Road, Suite 310 Wilmington DELAWARE 19808  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** JAMES EARL LOWE JR.  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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